



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,406	11/03/2000	James P. Tagg	TAG P-3	7866

7590

11/22/2005

STEPHEN M. CHIN  
REED SMITH LLP  
599 LEXINGTON AVENUE  
NEW YORK, NY 10022

EXAMINER

NGUYEN, HAI V

ART UNIT PAPER NUMBER

2142

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/706,406	<b>Applicant(s)</b> TAGG, JAMES P.	
	<b>Examiner</b> Hai V. Nguyen	<b>Art Unit</b> 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to the communication received on 10 August 2005.
2. Claims 1-20 are cancelled.
3. Claims 21-46 are new claims and presented for examination.

### ***Response to Arguments***

4. Applicant's arguments and amendments received on 10 August 2005 have been fully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground(s) of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., canceling claims 1-20 and adding new claims 21-46) to the claims which significantly affected the scope thereof.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 37 recites "the air interference". There is insufficient antecedent basis for this limitation in the claim.
8. Claim 38 recites "the data stream". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 21-24, 33 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by **Tummala et al. U.S. patent # 6,915,345 B1**.

11. As to claim 21, Tummala, discloses a method of connecting a client system (*Fig. 4, client home network 310*) to a target network (*Fig. 4, foreign network 340*) comprising:

configuring a tunnel in a host system (*Fig. 4, SLA Broker server 375*) under control of host system, wherein the host system is capable of accessing a target network (*Fig.4, the AAA broker server is configured with information about the clients with which it accepts requests from, col. 13, line 58 – col. 14, line 38; col. 7, line 41 – col. 8, line 59; col. 9, lines 19-65*).

connecting the client system to the host system under the control of client system, (*Mobile node makes the connection with the registration request and response*

Art Unit: 2142

*through the AAA servers, or the mobile node 64 can then initiate establishment of the secure connection; Fig. 2, col. 7, line 41 – col. 9, line 65).*

comparing preferences (*attributes*) of the host system and the client system under the control of a matching means (*a Service Level Agreement (SLA)*) (*Fig. 4, col. 6, lines 14-58; col. 11, line 40 – col. 12, line 36*).

establishing of a secure link from the client system to the target network through the tunnel in the host system when the preferences of the host system and client system match (*col. 11, line 40 – col. 12, line 36*); wherein the client system does not access any resources of the host system outside of said tunnel (*Fig. 4, col. 6, lines 14-58; col. 7, line 41 – col. 9, line 65; col. 11, line 40 – col. 12, line 36*).

12. As to claim 22, Tummala discloses wherein the comparing step is made in a server (*Fig. 4, server 375*).

13. As to claim 23, Tummala discloses wherein the target network is the Internet (*Fig. 4, item 335*).

14. As to claim 24, Tummala discloses wherein the target network is a public network (*col. 4, line 44*).

15. Claim 33 has similar limitations of claims 21 except for the limitation of “disconnecting the client system from the first host system” which is merely the session timeout AVP tagged to specify the cache timeout for particular host (*Tummala, col. 11, line 8 – col. 12, line 36*).

16. Claim 46 corresponds to the system claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 25-32, 34-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tummala** as applied to claims 21-24 above, in view of **Lynch** U.S patent # **6,487,600 B1**.

19. As to claim 25, Tummala does not explicitly disclose the target network is a PSTN. Lynch disclose that, *"the client communication device may take differing forms to provide telephone functions and PC functions along with the communication functions it provides. The network friend has the basic structure of a web server and may facilitate transactions via the Internet and/or the PTSN (Lynch, col. 4, lines 4-14)"* as evidenced by implementing the security across the PSTN (Lynch, col. 4, lines 29-39).

20. As to claim 26, Tummala-Lynch discloses wherein the client system is a mobile phone (*Tummala, Abstract; Lynch, col. 7, lines 16-26*).

21. As to claim 27, Tummala-Lynch discloses wherein the host system is a virtual private network (*Tummala, Abstract; col. 9, lines 55-65*).

22. As to claim 28, Tummala-Lynch discloses where the host systems and the client systems are members of service that gives reciprocal roaming rights (*Tummala, Abstract; col. 9, lines 55 – col. 10, line 14*).

Art Unit: 2142

23. As to claim 29, Tummala-Lynch discloses where the comparing step comprises the steps: determining a cost of obtaining a link and comparing the cost with a predetermined limit (*Tummala, SLA thresholds or attributes matched on the home network, claim 14-16*) stored by said client system where a match will be found if the cost is less than or equal to the predetermined limit (*Tummala, SLA thresholds or attributes matched on the home network, claim 14-16*).

24. As to claim 30, Tummala-Lynch discloses where the host system is not connected to the target network and will make connection to that target network upon request by a client system (*Tummala, the SLA broker is not connected if the client does not initiate the communication or as long as the SLA is valid, col. 9, line 19 – col. 10, line 14*).

25. As to claim 31, Tummala-Lynch discloses where the secure link through the tunnel comprises channels to transmit time divided data (*Tummala, messages*) (*Tummala, col. 9, line 19 – col. 10, line 14*).

26. As to claim 32, Tummala-Lynch discloses connecting a second client system to the first client system in order that the second client system is able to access the target network through the tunnel in the host system (*Tummala, the mobile nodes communicate each other through the secured channel or tunnel via AAA servers based on the valid SLAs, col. 9, line 19 – col. 10, line 65*).

27. As to claim 34, Tummala-Lynch discloses wherein the establishing step further comprises the step of notifying a user of the client system of availability of a link wherein

Art Unit: 2142

the user can accept or reject the connection (*Lynch, col. 13, line 15 – col. 14, line 13; col. 21, line 49 – col. 22, line 25*).

28. As to claim 35, Tummala-Lynch discloses wherein any data by the client system is encrypted prior to being sent to the network such that the privacy and security for the client are maintained (*Lynch, col. 3, line 55 – col. 4, line 49; col. 21, line 49 – col. 22, line 25; col. 35, lines 6-67*).

29. As to claim 36, Tummala-Lynch discloses, wherein the encryption can be selectively applied to the data depending on the preferences (*Tummala, col. 6, lines 14-58; col. 9, line 3 – col. 10, line 65*).

30. As to claim 37, Tummala-Lynch discloses, wherein the connecting step comprises the step of causing the host system to mimic the air interference for a cordless telephone link (*Tummala, the cellular transceiver 360, col. 6, lines 14-58; col. 9, line 3 – col. 10, line 65*).

31. As to claim 38, Tummala-Lynch discloses, converting the data stream into data packets for transmission over the Internet under the control of the host system (*Tummala, col. 6, lines 14-58; col. 9, line 3 – col. 10, line 65; Lynch, col. 13, line 15 – col. 14, line 13; col. 21, line 49 – col. 22, line 25*).

32. As to claim 39, Tummala-Lynch discloses where the client configuration is performed automatically by the host when the host system is first power on (*Lynch, col. 21, line 49 – col. 22, line 25*).



Art Unit: 2142

33. AS to claim 40, Tummala-Lynch discloses wherein the connecting step comprises using wireless once connection technology (*Tammala, Abstract; Lynch, Abstract*).

34. As to claim 41, Tummala-Lynch discloses wherein the establishing step occurs automatically once the match is made (*Tammala, col. 6, lines 14-59; Lynch, col. 21, line 49 – col. 22, line 25; col. 35, lines 6-67*).

35. As to claim 42, Tummala-Lynch discloses wherein the packets are VoIP (*Lynch, col. 3, line 55 – col. 4, line 49; col. 21, line 49 – col. 22, line 25; col. 35, lines 6-67*).

36. As to claim 43, Tummala-Lynch discloses wherein the packets are sent over any available port in order to pass through a firewall (*Tammala, Fig. 4, items 347, 319*).

37. As to claim 44, Tummala-Lynch discloses wherein the client system connects to and disconnect from the host system and second host system under the control of said matching means (*Tummala, based on SLAs*).

38. As to claim 45, Tummala-Lynch discloses wherein the connecting step comprises the step of coordinating the different frequencies used by the client system | connecting to the host system (*Lynch, col. 3, line 55 – col. 4, line 49; col. 21, line 49 – col. 22, line 25; col. 35, lines 6-67*).

39. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

### ***Conclusion***

40. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen  
Examiner  
Art Unit 2142



THONG VU  
Primary Examiner

